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09/725,048	11/29/2000	Roland Bazin	05725.0800-00	8605

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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/725,048

Applicant(s)

BAZIN ET AL.

Examiner

Amanda F. Wieker

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-20, 24-48, 59, 61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) 5, 9, 10, 12-20 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6-8, 11, 25-48, 59, 61 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Species A, Subspecies I in the reply filed on 27 January 2006 is acknowledged. The traversal is on the ground(s) that: 1) a serious burden does not exist if all claims continue to be examined; and 2) the listed species do not correspond to a listing of species that is mutually exclusive because certain exemplary methods may combine more than one figure, and some exemplary methods might not involve the cited figures.

This is not found persuasive because:

1) although all of the claims had been examined previously, that examination was based on the presumption that equivalence existed between the various Species and Subspecies, however based on the prosecution history and Applicant's comments, it has become clear that Applicant does not consider the Species and Subspecies to be equivalent. Therefore, the scope of examination has changed, and a serious burden would exist, if the examiner were required to continue examination of non-equivalent species; and

2) the examiner has identified for election all of the Species and Subspecies that have been disclosed, enabled and illustrated in the specification. The examiner will only examine those species that have been disclosed, not those that may be speculated. If Applicant believes that other Species and Subspecies exist that are enabled and fully supported, Applicant is invited to identify those Species/Subspecies that are believed to exist, along with an identification of their places of support in the Specification. The examiner would consider these identified Species/Subspecies, and a determination will be made as to whether an additional election of species requirement should be presented.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant indicates that claims 4, 6-8, 11, 12, 14-20, 24-48, 59, 61 and 62 are directed to the elected embodiment. The examiner disagrees.

Claim 12 recites: "the transfer member is a window, the window being a portion of the image scanner defining a scanning region". This claim limitation is drawn to Species B, shown in Figure 8, and does not "read on" the elected Species A, shown in Figures 2-5, and the elected Subspecies I as shown in Figure 6. Consequently, claim 12 is withdrawn from consideration.

Claim 14 recites: "placing the external portion of the individual in the vicinity of a scanning region of the image scanner; and scanning the external portion with the image scanner". This claim limitation is drawn to Species B, shown in Figure 8, and does not "read on" the elected Species A, shown in Figures 2-5, and the elected Subspecies I as shown in Figure 6. Claims 15-20 depend from claim 14, and incorporate the same non-elected claim limitation. Consequently, claims 14-20 are withdrawn from consideration.

Claim 24 recites: "the external portion includes at least one strand of hair". This claim limitation is drawn to Species B, Subspecies ii, shown in Figures 15-16, and does not "read on" the elected Species A, shown in Figures 2-5, and the elected Subspecies I as shown in Figure 6. Consequently, claim 24 is withdrawn from consideration.

Claims 12, 14-20 and 24 are withdrawn from consideration.

3. Claims 5, 9-10, 12-20 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species and Subspecies, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 27 January 2006.

*Claim Rejections - 35 USC § 102(b)*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4, 6, 37, 46-48, 59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,343,536 to Groh.

Regarding claims 4 and 6, Groh discloses a process for acquiring scanned image data relating to an external body portion (skin) and/or a product applied to the external body portion, the process comprising:

placing a transfer member (11) in contact with an external portion (skin with adhesive) of an individual so as to obtain a transfer image (16) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (col. 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic of

the external body portion (cell and comedone presence, size, etc), and/or

at least one product applied to the external body portion,

wherein the transfer member is placed in contact with an external body portion that is inherently capable of including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product (The system disclosed by Groh is used to detect comedones, which often appear on the face. Any facial cosmetic worn by the patient (i.e., moisturizer, foundation makeup, etc) would inherently be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data).

Regarding claim 48, information regarding the transfer image is collected to form a database (computer storage of binary filtered and normalized data, retrievable therefrom; col. 3, lines 1-32) for use in diagnosis or treatment recommendation determinations. Regarding claim 37, the image can be compared to at least one other image formed from image data stored in and retrievable from an image database (col. 3, lines 1-32).

Regarding claim 46, the image is displayed and viewed to analyze the characteristic of the external body portion. Regarding claim 59, the analysis is performed using an image analyzer. Regarding claims 61-62, a "grade" (average number of comedones) that is indicative of at least one condition (accumulation of dirt in sebaceous glands) of the external portion is provided and stored in a database (col. 3, lines 1-32).

#### *Claim Rejections - 35 USC § 102(e)*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 4, 7, 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Number 6,533,971 to Stess et al.

Stess et al. disclose a process for acquiring scanned image data relating to an external body portion (torso) and/or a product applied to the external body portion, the process comprising:

placing a transfer member (25/27; col. 5, lines 36-41) in contact with an external portion (torso; in contact via 23) of an individual so as to obtain a transfer image (mold) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (51) to obtain scanned image data for an image representative of at least one characteristic of

the external body portion (shape, surface contours, etc), and/or

at least one product applied to the external body portion,

wherein the transfer member is a moldable material, and wherein the process includes placing the moldable material in contact with the skin of the individual (via release layer 23) to

produce, on the moldable material, the surface profile of the skin. Although the transfer member (25/27) is not placed into direct contact with the skin, this is not required by the claim. Furthermore, the release layer can be extremely thin (0.005 inches in thickness), which allows the transfer member to be in sufficient enough contact with the skin to produce the surface profile of the skin on the moldable material.

The transfer member is placed in contact with an external body portion (via release layer 23) that is inherently capable of including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product (The system disclosed by Stess et al. is used to make a mold of the torso. The surface profile of any cosmetic product worn by the patient (i.e., moisturizer, lotion, etc) would inherently be captured when the transfer member is placed in contact with the external portion (via the release layer), and such cosmetic would be part of the scanned image data).

The transfer member is a fabric formed as an article of clothing (shirt).

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 25-36 and 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groh in view of Kvedar (Kvedar, J.C. et al. (1999). Teledermatology in a Capitated Delivery



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System Using Distributed Information Architecture: Design and Development. *Telemedicine Journal*, 5(4), 357-366.).

Groh discloses the previously described process for acquiring scanned image data relating to an external body portion, the process comprising:

placing a transfer member (11) in contact with an external portion (skin with adhesive) of an individual so as to obtain a transfer image (16) on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner (col. 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic of

the external body portion (cell and comedone presence, size, etc), and/or

at least one product applied to the external body portion.

The image scanner is associated with a first computer (col. 2, last line). Groh does not specify transmitting the image to another computer/location for analysis.

Kvedar et al. disclose a process for acquiring scanned image data relating to an external body portion. Kvedar et al. disclose that an image of an external body portion is captured and image data for the image representative of the external body portion is uploaded onto a first computer. The process may further include transferring the scanned image data, via the Internet, to a second computer located at a location remote from the first location (p. 361, for example), so that other users (specialists) can view the images for consultation, to allow remote

and repeatable analysis of a condition of the external portion. Kvedar et al. also disclose storing the scanned image data on a data storage medium (computer file), and wherein the transferring may include shipping (via email attachment) the data storage medium to the second location. Once the image data is transferred to the second location, the image is displayed at the second location and viewed to analyze the image characteristics. Kvedar et al. disclose that the scanned image data can be sent to a plurality of locations to be analyzed numerous times. Kvedar et al. disclose that after the data is sent to a second location and analyzed, a recommendation for treatment can be provided (p. 362, col. 2; “(2)”), wherein the external portion is monitored during treatment (“Routine follow-up calls”) and information is provided regarding the effectiveness of the treatment (“assess their progress”). The recommendation is inherently capable of being any recommendation determined by the specialist, including the use of a cosmetic or dermatologic product on the external portion (Kvedar et al. disclose this procedure to be used in treatment of *dermatologic* disorders, which are inherently treatable with *dermatologic* products). The treatment recommendation is provided to the individual and/or treatment provider (p. 362; col. 2) via the Internet. Kvedar et al. disclose transferring questionnaire data (“history forms”) to the second location, wherein some of the data concerns the condition of the external product and any products applied thereto. The examiner takes Official Notice that in the process disclosed by Kvedar et al. it would have been obvious to send “at least one of billing information and payment information” to the second location, as is common business practice, in order for the consulting specialist to receive payment for their services. This is well within the performance of a normal business interaction, well known to one of ordinary skill in the art. The examiner also takes Official Notice that in the process disclosed by Kvedar et al. it would have been obvious to provide product-ordering information

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along with the treatment recommendation given by the specialist, as is common practice, in order for the patient to obtain the product to be used for treatment. This is well within the performance of a normal patient-client interaction, well known to one of ordinary skill in the art.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the process for acquiring scanned image data, as disclosed by Groh, wherein the image data is transferred to a second location and analyzed with the process taught by Kvedar et al., to allow remote and repeatable analysis of a condition of the external portion.

#### *Allowable Subject Matter*

10. Claim 11 is allowed.

11. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

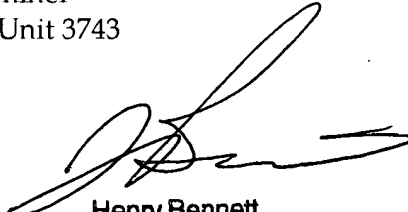
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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